

# BEST AVAILABLE COPY

FROM McANDREWS, HELD, & MALLOY

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Application No. 10/654,413  
Attorney Docket No. 15047US01

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## REMARKS

The present application includes claims 1-17, 19-23 and 37-44. Claims 1-17, 19-23 and 37-44 were subject to a Restriction Requirement.

In the Restriction Requirement, the Examiner identified five groups of claims and identified each of the groups as a species, as set forth below:

Species I - Claims 1-17 and 19-23 (including independent claims 1 and 12)

Species II - Claim 37

Species III - Claim 38

Species IV - Claim 39

Species V - Claims 40-44 (including independent claims 40 and 41)

Additionally, the Examiner identified claim 5 as generic.

The object of this Response is to secure a fair examination for a client that may lack the resources of a larger client - not to point out shortcomings in the Restriction Requirement. If the Examiner feels unduly burdened, the Applicant would be open to discussing the currently pending claims with the Examiner and potentially canceling some of the claims and may be reached at the phone number below. However, as further described below, the offered 5-way restriction requirement seems unwarranted in light of the claims that the Examiner has already searched and issued an Office Action on and the similarity of the new claims to the already searched claims.

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Specifically, as further described below, the claims identified as Species I and II have already been searched by the Examiner and the Examiner issued an Office Action on the merits on October 18, 2005. Consequently, it is respectfully submitted that there can be no showing of undue burden on the Examiner to support restriction between the claims identified as Species I and II.

Claims 38 and 39 which are identified as being in Species III and IV are highly similar to claim 1 which is identified as being in Species I, which has already been searched and Examined. Consequently, it is respectfully submitted that there can be no showing of undue burden on the Examiner to support restriction between the claims identified as Species I, II, III, and IV.

Further, claim 41 which is identified as being in Species V is highly similar to claim 37 identified as Species II, which has already been searched and Examined. Consequently, it is respectfully submitted that there can be no showing of undue burden on the Examiner to support restriction between the claims identified as Species I-V.

Thus, the Applicant respectfully requests that Examination proceed with regard to the claims identified as Species I-V. As further discussed below, if the Examiner refuses to proceed with the claims identified as Species I-V, then the Applicant provisionally elects the claims identified as Species I, with traverse.

#### **1) Improper Identification As Species**

MPEP 806.04(e) states that "claims are never species" and that "species are always the specifically different embodiments." Consequently, the Applicant respectfully asserts that the

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identification of the claims as Species I-V is improper in two ways. First, grouping the claims into Species I-V and requiring an election of one of Species I-V is improper because the claims are not species and should not be titled as species.

More importantly, the MPEP specifically recites that species are specifically different embodiments. Conversely, using different language in two instances to claim a single embodiment does not result in two species. For example, claim 1 and claim 38 are drawn to the same embodiment, as disclosed in the specification: the embodiment includes a barrier (as recited in claim 1) and a particulate layer (as recited in claim 38). Claiming two aspects of a single embodiment does not result in two species. Consequently, an attempt to restrict examination in this fashion is improper. This reasoning applies to all of the claims identified as species.

## **2) Improper Identification as Generic**

Claim 5 ultimately depends from independent claim 1. However, the Examiner has identified claim 5 as generic, but has identified claim 1 as a species. This is not possible. See MPEP 806.04. Consequently, the restriction requirement is improper.

Additionally, the Applicant traverses the Examiner's assertion that claim 5 is generic.

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**3) Failure To Show That There Would Be An Undue Burden On The Examiner**

Under MPEP 808, the Examiner must set forth the reasons why there would be a serious burden on the Examiner if restriction is not required. There has been no such showing here. Consequently, the restriction requirement is improper.

Thus, for the reasons discussed above, the Applicant respectfully submits that restriction is improper at this time and requests that examination proceed with regard to all of claims 1-17, 19-23 and 37-44.

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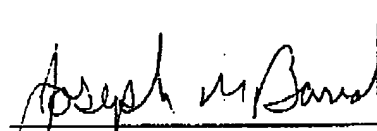
**CONCLUSION**

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: December 19, 2005

  
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